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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 358623.00100	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>September 22, 2006</u> Signature <u>Maryalice Kelley</u> Typed or printed name <u>Maryalice Kelley</u>		Application Number 10/091,860	Filed March 6, 2002
		First Named Inventor Steven R. Cox	
		Art Unit 3626	Examiner V. Koppikar

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)
- ☒ attorney or agent of record.
Registration number 39,240
- ☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

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September 22, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☐ *Total of _____ forms are submitted.

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Attorney's Docket No. 358623.00100

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of:

Steven R. Cox, Thomas R. Quirk

Application No. 10/091,860

Filing Date: March 6, 2002

For: SYSTEM FOR IMPROVING
LOGISTICS, TRACKING AND
BILLING FOR WORKER'S
COMPENSATION INSURANCE

Examiner: Koppikar, Vivek D.

Group Art Unit: 3626

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Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

This Request for Review is taken from the final rejection mailed Aug. 10, 2006. Claims 1 – 14 were pending and the Office Action rejected all claims. Specifically, Claims 1 – 5, and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Pub. No. 20020184055 to Naghavi, in view of U.S. Patent No. 6,057,764 to Williams, in further view of Japanese Patent No. 10-48008 to Omron. Claims 6 – 9 were rejected under 35 U.S.C § 103(a) as being unpatentable over Naghavi, in view of Williams, in view of Omron, in further view of U.S. Patent No. 6,604,080 to Kern. Finally, Claim 11 – 14 were rejected under 35 U.S.C § 103(a) as being unpatentable over Omron, in view of Williams, Naghavi and Kern.

The present claims are directed to a method and system that tracks the amount of time a worker spends in an area (i.e. liability zone) or areas of a workplace environment. By tracking the amount of time a worker spends in areas which may have different possible exposure levels for risk of injury, a fair assessment can be made as to the amount of worker's compensation premium that should be paid for that worker's activities.

As discussed below, there is no teaching or suggestion in the cited prior art of such a method and system. Even assuming the disparate elements could be found in the cited prior art (which the Applicants contend they cannot), the Examiner has failed to establish any reasonable basis for finding any motivation in the prior art to make such a combination from the completely unrelated prior art references. The Office Action is based entirely on hind-sight reconstruction using the applicants' teachings and claims as a guide. The Federal Circuit has repeatedly held such a rejection is improper.

As understood by the applicants, Naghavi merely discloses a proprietary healthcare operating system for a PC specifically adapted to interface with medical devices connected to a PC. Naghavi does not disclose detecting a human in an environment, nor does Naghavi disclose tracking an amount of time the human spends in any particular area in the environment in order to determine a measure of risk exposure or an insurance premium. Moreover, the Applicants contend that this reference is not even relevant art, since it is not directed to solving the same or similar problem, and has no mention whatsoever of tracking workers for determining an insurance premium.

Williams discloses an alarm system whereby a detected person may have a personal device that transmits an authorization code to prevent the alarm system from activating. As with Naghavi, Williams does not disclose any system or method for tracking an amount of time a person spends in different areas, nor that this time information is used to determine a measure of risk or assessment or to calculate an insurance premium. As with Naghavi, Williams does not teach or disclose that a measure of risk or an insurance premium may be based on an amount of time a worker spends in a predefined area (liability zone).

Kern discloses a computer system used to calculate worker's compensation insurance rates. As understood by the Applicants, this system is merely a standard computer system used to calculate insurance rates and premiums, and is not directed to any new methodology for calculating worker's compensation insurance premiums based upon an amount of time a worker is in various liability zones.

These three references were initially cited in the first Office Action as supporting the rejection of the claims. Realizing that none of these three references even mention tracking an amount of time a worker spends in an area in order to calculate an insurance premium, the Final Office Action added the Omron reference.

However, Omron is similarly deficient. As understood by the applicants, Omron appears to disclose a system that determines how long a person stays near an exhibit or store display. Omron does not disclose tracking a person in an area in order to make a risk assessment or calculate an insurance premium. This specific limitation is completely absent from the cited prior art references.

Specifically referring the claim rejections, Claim 1 requires “using the amount of time to derive a measure of risk exposure to the human.” Neither Naghavi, Williams or Omron teach or suggest this element. Moreover, it appears the Examiner has misapplied Williams, since the Office Action citations to Williams are merely to discussion of an alarm system that monitors individuals entering a building, etc. but has no mention of using this information to derive a measure of risk exposure.

Similarly, independent claims 10, 11 and 14 all require detecting an amount of time a person spends in an area, and calculating an insurance premium based at least in part on the detected time. None of the four cited references teach or suggest this limitation. It is unclear how one of skill in the art could even combine these four disparate references and form the present invention, since the most basic point – tracking the amount of time a worker spends in different liability areas in order to calculate an insurance premium– is not taught or suggested by any of the references.

In summary, the four cited references, either individually or taken as group, do not reasonably suggest to one of skill in the art that an insurance premium can be calculated based upon tracking an amount of time a worker spends in at least one area (liability zone). For at least this reason, it is believed that the present claims are now in condition for allowance.

Furthermore, the four references appear to be so unrelated that it is unreasonable to presume that one of skill in the art would even look to these four references in order to form the present invention (Naghavi discloses a healthcare operating system; Williams discloses an alarm system; Kern discloses a computer system to calculate insurance rates; Omron discloses a system for monitoring customers at product displays).

As stated by the Federal Circuit in *In re Clay*, 23 USPQ 2d 1058, 1060-61 (Fed. Cir. 1992):

Two criteria have evolved for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, and (2) if the reference is not within the same field of endeavor, whether the reference still is reasonably pertinent to the particular problem with which

the inventor is involved....A reference is reasonably pertinent if....it is one which, because of the matter with which it deals, logically would have commended itself to the inventor's attention in considering his problem...If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, ...[i]f it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it.

In this case, the cited references are not even in the field of method or systems for calculating insurance based on physical factors, such as a presence in defined zones. As such, an inventor would hardly have considered them when constructing a system such as the present system.

Additionally, none of these references provide any motivation for the hypothetical combination now proposed by the Examiner, and it appears that the Examiner is merely using the teachings of the present invention to select elements from disparate documents – i.e. is engaging in impermissible “hindsight reconstruction.” The Federal Circuit has specifically addressed this issue in *In re Oetiker*, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992):

The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge cannot come from the applicant's invention itself.

As noted above, however, there is no basis supplied in the prior art which would motivate someone to make this combination, since the references are not even directed to solving the same or similar problem. Moreover, this combination fails in any event, since none of the cited documents disclose tracking an amount of time a person spends in an area in order to calculate an insurance premium.

In view of the above arguments, the Applicants respectfully request that the finality of the Office Action be overturned and either the case passed to issuance, or more relevant art be cited. If new art is cited, the Applicant should be able to respond to a new Office Action as if the action is a first action, since the cited references are so deficient (as detailed above).


If a telephone interview will help expedite the prosecution of this case, please contact the undersigned attorney at the telephone number listed below.

The Commissioner is hereby authorized to charge any fees (or credit any overpayment) associated with this communication and which may be required under 37 CFR §1.78 to Deposit Account No. 50-2603, referencing Attorney Docket No. 358623.00100. **This document is submitted in duplicate.**

Respectfully submitted,

REED SMITH LLP

Dated: September 22, 2006

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Dated: September 22, 2006


Maryalice Kelley